

REMARKS

The Examiner's indication that claim 13 would be allowable in independent form has been noted with appreciation. In light of the following amendments and remarks, it is respectfully submitted that all claims are now in condition to be allowed.

The sub-group in claim 5 has been separated into a new dependent claim as suggested by the Examiner. It is therefore respectfully submitted that the rejection to claim 5 can be withdrawn.

Claim 16 has been replaced by claim 20 which is a more conventional U.S. method claim having an active, positive step. It is respectfully submitted that the rejection under § 112 is not applicable to this rewritten claim.

A number of additional dependent claims have been added to this case. The basis can be found in the claims already pending.

The claims, other than claim 13, were rejected under 35 U.S.C. § 102 over Horvat. It is respectfully submitted that in light of the deletion of trehalose as a possible sugar or sugar alcohol, the novelty rejection can be withdrawn.

It is respectfully submitted that no new rejection based on obviousness is appropriate. The Horvat patent relates to a marking fluid and points out that the prior art fluids had been subject to the problem of fading or becoming completely erased. Horvat sought to improve the fastness to light and for that purpose teaches incorporating certain saccharides into the composition.

Horvat is based on German application DE 40 20 901. At the same time as the German priority application was filed, Horvat also filed another German application DE 40 20 900 which describes a marking fluid based on an aqueous solution of

hydroxy-pyridine-trisulfonic acid into which saccharose, lactose, maltose as well as their monosaccharides or mixtures of their saccharides are added. In this writing fluid, an isothiazolinone derivative was employed as a preservative and there was a water soluble bonding agent and wetting agents. The description of this companion Horvat reference is taken from U.S. 5,486,550 (copy attached) which, since it is based on the same foreign application priority data as DE 43 209 59.9, appears to be an English language equivalent of the German reference which is already of record in this application.

The Examiner will note from the first column of the attached '550 patent that while the Horvat marking fluids may have been an improvement over the marking fluids which existed before them, they still suffered from a particular disadvantage of having limiting lightfastness. The '550 patent addresses this problem by employing a color pigment formed of at least one alkaline dye and at least one solid polymer dispersion component, at least acid group-free polyhydroxy compound as a stabilizer and additionally, at least one surfactant and/or emulsifier and preservatives.

The problem addressed by the present invention is the provision of marking fluids and methods for the manufacture of them that ensure improved lightfastness and luminosity of the marker substance that is present in the fluid without the occurrence of color deterioration after the marking fluid is applied to substrates. (See page 2, second paragraph). The invention has been realized by employing alternative sugars to the sugars mentioned by Horvat. Since the art had recognized that the use of the sugars disclosed by Horvat did not solve the problem of lightfastness, a person skilled in the art would not have been motivated to try alternative sugars as a means of solving the problem and increase lightfastness. Instead, the skilled person would have, in the same way as the inventor in the '550 patent did, search for materials which could be added to the marking fluid and act as a lightfastness stabilizer. Nothing in the prior art

suggested that the sugars or sugar alcohols recited in the instant claims would give improved light fastness. Nevertheless, as shown in the working examples of the present application, they do. This result is surprising and unexpected.

In light of the foregoing amendments and remarks, it is respectfully submitted that this application is now in condition to be allowed and the early issuance of a Notice of Allowance is respectfully solicited.

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Respectfully submitted,

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